REMARKS

Claims 1-25 and 27-32 are currently pending in the subject application and are presently under consideration. Claims 26 and 33 were previously cancelled. Claims 1, 3, 4, 13, 15, 21, 27, 31 and 32 have been amended as shown on pp. 2-8 of the Reply.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1, 21, and 31 Under 35 U.S.C. §101

Claims 1-20, 21-25 and 27-32 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 15, 21 and 31 have been amended to more clearly indicate that the applicants are not seeking protection for software *per se*. The Examiner is respectfully requested to withdraw the 35 U.S.C. § 101 rejection of claims 1-20, 21-25 and 27-32 in light of these clarifying amendments.

II. Rejection of Claims Under 35 U.S.C. §112

Claims 1-14 stand rejected under 35 U.S.C. §112, 1st para., because the Office asserts that the terms "computer implemented" and "processor" are new matter. Applicants' representative respectfully disagrees. The specification, as originally filed, includes Figure 10 and the related textual description of Figure 10, which more than adequately describes a computer environment including computer processors and computer memories that can facilitate implementation of the claimed subject matter. It is well settled that 35 U.S.C. § 112, 1st paragraph, is oriented to preventing the inclusion of new matter, by which is meant, matter that is not expressly or inherently disclosed in an application as filed. This prevents the applicant from expanding the scope of the application beyond that which was in the possession of the inventors at the time of filing. The inclusion at the time of filing of figure 10 and the correlating text (see pages 16-19) clearly establishes that the applicants understood that the disclosed subject matter could be practiced in a computer implemented environment which could include various processors and memories. As such, inclusion of these aspects in the claims is well within the purview of the applicants and does not run afoul of 35 U.S.C. § 112, 1st para. It is respectfully requested that the rejection under 35 U.S.C. § 112, 1st para., be withdrawn.

Claims 1-14, 27, 31, and 32 stand rejected under 35 U.S.C. § 112, 2nd para., as being indefinite. The Examiner is thanked for pointing out this deficiency. The claims have been amended to correct the improper Markush group by changing the "and" to a non-exclusive "or" among the several claims. Applicants' representative, in light of the amendments, respectfully requests that the 35 U.S.C. § 112, 2nd para. , rejection be withdrawn.

The Office asserts that substantial portions of the claimed subject matter are not afforded patentable weight where the claim language is deemed non-functional descriptive material. Applicants' representative respectfully disagrees with this position. These enumerated aspects of the disclosed subject matter, for example, clearly alter how a paid inclusion listing is enhanced or interacts. As such, each of the more narrowly drawn particular enumerated examples describe that which the applicants believe is well within the scope of their disclosed subject matter. For instance, these particular enumerated enhancements are not mere non-functional descriptive language because they specifically disclose a particular enhancement that may not have the same effect on a user as a different enumerated enhancement (*e.g.*, were the enumerated enhancements merely non-functional, then the enhancements would be completely interchangeable without any effect, which is certainly not the case) (*see* how different enhancements can have a substantial effect on the consumption of listings as presented in the specification at page 11, line 24 to page 12, line 2; page 15, lines 14-18; etc.) For example, changing the color of text is an enhancement that is clearly different from underlining the same text, italicizing the same text, flashing the same text, or changing the size of the same text, with regard to how the particular enhancement impacts a user viewing the text. As such, where each of these special subclasses of enhancement can have a particular desired effect on a user, the enumeration is not merely non-functional description. Applicants' representative respectfully asserts that the particular types of enhancements are significant where they are employed to narrow the scope of a claim from which they depend or wherein they describe a particular type of enhancement believed to be specially valued as employed in the scope of the claimed subject matter. Applicants' representative respectfully requests that the Office not give short shrift to the specific claim language and that the cited language of claims 4, 5, 6, 7, 9, 10, 27, 28, and 29 not be treated as mere non-functional descriptive language during examination of the instant application.

More specifically, claim 4 recites an enumerated list of enhancements that can each have a particular effect on the end-user perception of the paid inclusion listing and is believed to carry

patentable weight. Claim 5 states that the enhancement changes in response to a user interface action and as such is believed to have patentable weight. Claims 6 asserts a narrow and particular type of enhancement believed to have a particularly desirable effect and as such is within the scope of the applicants disclosure to claim and is believed to carry patentable weight in light of the various effects different enhancements can induce in end-users as asserted *supra*. Claim 7 is believed to have patentable weight for the same reason as asserted with regard to claim 6. Claim 9 recites that the enhancement does not influence a listing propensity and therefore is believed to have patentable weight as this distinguishes the claim from enhancements that would influence listing propensity. Claim 10 relates that the enhancements are sufficient to cause a differentiation from non-enhanced listings on a display and thus has patentable weight where these can be different from enhancements that do not cause distinction (*e.g.*, imperceptible enhancements, etc.) Claim 27, is believed to have patentable weight for the same reasons as asserted with regard to claim 4. Claim 28 describes applying the enhancements to a subset of listings and thus will have a particular effect that is believed to have patentable weight. Claim 29 is directed to enhancement interactions with human interface devices and is believed to have patentable weight. The applicant respectfully requests that the claims be fully examined as presented.

III. Rejection of Claims 1-2, 4, 11-15, 19-21 and 23-25 Under 35 U.S.C. §103(a)

Claims 1-2, 4, 11-15, 19-21 and 23-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez (US 2004/0059720 A1) in view of Wen (US 2001/0047297 A1). Applicants' representative respectfully traverses the rejection.

Applicants' disclosed subject matter relates generally to, "visually enhancing **paid inclusion listings** to facilitate offering a clear and substantial value to **paid inclusion advertisers** while retaining ordering rights to keep listings relevant to users", (*see* pg. 2, ln 14-18). More specifically, the applicants' disclosed subject matter allows enhancement of listings by **the paid inclusion advertisers**, which is in not limited to end user sorting and filtering. Value is added to paid inclusion list advertisement placement by allowing the advertiser to emphasize their advertisement listings (*e.g.*, listings of advertisements produced from, for example, a search engine, as compared to the advertisements themselves).

The invention of Rodriguez is generally directed to searching and sorting multimedia and other data. More specifically, Rodriguez allows searches that can be sorted and filtered based on **end user** input. Rodriguez does not disclose, either expressly or inherently, any form of enhancement other than sorting and filtering by the **end user**.

The invention of Wen is generally directed to enabling advertisers to create advertisements that can be marketed by an ad broker system (*see* Wen abstract). While Wen does discuss user friendly methods of creating advertisements, including selecting and incorporating numerous eye-catching characteristics within the advertisement, *Wen never raises or discloses any aspect of enhancing* ***paid inclusion listings***. The difference between an advertisement and a 'listing of a plurality of search results and/or advertisements' (*e.g.*, wherein the paid inclusion listing(s) is an element of the set of listed results) is an important distinction between Wen and the instant application.

The Examiner states that the applicant has "defined" a paid inclusion customer as an "advertiser", applicants' representative STRONGLY disagrees. The specification, as filed, at the portion cited by the Examiner, merely states: "[a provider] can offer...enhancements to paid inclusion customers (hereinafter, referred to as "advertisers") to affect the rendering of any paid inclusion listing…", illustrating that the term advertiser can be used as a shorthand notation for the longer term 'paid inclusion customer' as used in the present application, which is reasonably interpreted to mean that ***not*** *all advertisers are paid inclusion customers*. Thus Wen's *advertiser search engine listing enhancements* *are absolutely different that enhancement of paid inclusion listings* given the substantial discussion provided in the application as filed differentiating standard search engine advertising from paid inclusion listings. As discussed during a previous telephonic interview (09 April 2008 at 3pm), enhancing paid inclusion listings, as compared to general advertising enhancements, is an aspect of novelty. The applicants' representative has made every effort to clearly narrow the claims to illustrate this aspect and clarify that the disclosed subject matter differs from highlights made to standard search engine advertising.

More specifically, claim 1 recites, "a selection component that allows *a paid inclusion customer to select one or more enhancements related to a paid inclusion listing*", emphasis added. Rodriguez is silent with regard to this aspect, merely disclosing end user enhancements to text that cannot be considered a paid inclusion listing. Wherein, the Office cites Rodriguez at paragraph [0007] as teaching enhancing a paid inclusion listing (*see* OA at pg. 8), applicants'

representative disagrees with the interpretation and asserts that, in fact, Rodriguez at [0007] actually merely discloses that paid inclusion listings exist and that they negatively affect web commerce (*e.g.*, in the background section of Rodriguez at [0007], *Rodriguez disparages paid inclusion listings*, see *infra*). As such, *it is nonsensical that Rodriguez would then support enhancing said paid inclusion listings after just stating that paid inclusion listings were bad.* Moreover, Rodriguez at [0007] never, in fact, discloses any "enhancement" of the paid inclusion listing at all. Wherein Rodriguez is actually oriented to end-user enhancements of general web listings, Rodriguez actually teaches away from enhancing paid inclusion listings, this is illustrated by the disparagement of paid inclusion listings *in toto* as recited, "Unfortunately this practice [paid inclusion listing] introduces *substantial imperfection* into the frictionless marketplace that the Web would become, because millions of *naïve users are being frequently directed to sites which have paid a premium for preferred placement*, rather than to sites which may have more pertinent information…", emphasis added. Rodriguez then goes on to say at [0021-0023] that the searcher should control the way search results are listed, in essence to improve searching by countering paid inclusion listings. Thus, Rodriguez cannot be interpreted to obviate enhancement of paid inclusion listings at all, and more particularly, cannot obviate paid inclusion customer enhancement of paid inclusion listings (*e.g.*, those paying to have the paid inclusion advertisement) as presented to end users and claimed explicitly in claim 1. Thus, with regard to the instant application, Rodriguez merely discloses the existence of paid inclusion listings.

The Office then turns to Wen to cure the defects of Rodriguez, namely that paid inclusion listings can be enhanced by the paid inclusion listing customer. Wen, in fact, does not disclose this aspect. Wen merely discloses that general web advertising can be enhanced by an advertiser through a third party interface (*e.g.*, the advertisement brokering service.) No combination of Rodriguez and Wen yields the explicitly claimed aspects as asserted *supra*. Where Rodriguez disparages paid inclusion listings and Wen is silent with regard to paid inclusion listings, it is clear that one of skill in the art would not have been motivated by the references to achieve the claimed subject matter including the recited, "selection component that allows *a paid inclusion customer to select one or more enhancements related to a paid inclusion listing*".

Similar arguments apply to claim 15 which recites, "one or more enhancement components…***related to a paid inclusion listing***…a listing control component that controls the

one or more enhancement components…a first input component that ***provides the listing control component with a paid inclusion customer's enhancement selections***", emphasis added. Where Rodriguez and Wen, either alone or in combination, do not disclose or suggest this aspect of the claimed subject matter as asserted herein, claim 15 is believed to be allowable. Moreover, neither Rodriguez nor Wen disclose or suggest, "the listing control component ***balances the customer's enhancement selections with user preferences*** to optimize listing performance", emphasis added. The assertion that Rodriguez discloses this aspect at [0049] is misplaced wherein Rodriguez actually discloses only end user enhancements of general search results and never discloses any enhancements performed to paid inclusion listings. As previously asserted, Wen does not cure this defect where Wen is silent with regard to paid inclusion listing customer enhancements of paid inclusion listings. For at least these reasons, claim 15 is believed to be allowable.

The language of claim 21 follows a similar pattern reciting, "***modifying*** at least a subset of the plurality of listings ***according to one or more paid inclusion customer selected enhancement options***", emphasis added. As asserted *supra*, Rodriguez merely discloses the existence of paid inclusion listings but disparages these types of listings and Wen merely discloses modifying standard search results per an end-user preference. As such, no combination of Rodriguez and Wen obviates modification of listings according to a paid inclusion customer enhancement option. It is further noted that the prior amendment adding an "s" to the term "customer" is withdrawn, as the correct grammatical reading of is: the listing is modified according to an enhancement option, the enhancement option being more narrowly defined by the adjective phrase "paid inclusion customer", resulting in one or more "paid inclusion customer enhancement options" (*e.g.*, the plurality describes options rather than customers). As such, claim 21 is believed to be allowable over any combination of Rodriguez and Wen.

Claim 31 is believed to be similarly allowable where it recites, "*enhancing…the at least one paid inclusion listing,* ***with at least a first paid inclusion customer selected enhancement****…enhancing at the at least one paid inclusion listing,* ***with at least a second enhancement***, the second paid inclusion customer selected enhancement being different from the first paid inclusion customer selected enhancement such that the modified paid inclusion listing is different as represented in the first subset from the modified paid inclusion listing as

represented in the second subset", emphasis added. For the same reasons as asserted with regard to claim 21 *supra*, claim 31 is believed to be allowable.

Thus, in regard to independent claims 1, 15, 21 and 31 of the subject application, Wen does not cure the deficiencies of Rodriguez, as discussed *supra*. Rodriguez merely discloses the existence of paid inclusion listings but disparages them with regard to their ability to artificially impact "naïve users" with regard to search results. Rodriguez is silent with regard to actually disclosing paid inclusion customer enhancement of paid inclusion listings. Wen does not cure this defect where Wen merely discloses augmenting general search listings though a third party advertising agent. As such, no combination of Rodriguez and Wen disclose or suggest paid inclusion customer enhancement of paid inclusion listings as explicitly claimed. Additionally, for the same reasons, applicants' representative respectfully submits that claims 2, 4 and 11-14 which depend from independent claim 1; claims 19-20 which depend from independent claim 15; and claims 23-25 which depend from independent claim 21, are allowable. Therefore, based on the above remarks, the applicants' representative respectfully requests that the Examiner withdraw the rejection of claims 1-2, 4, 11-15, 19-21 and 23-25 under 35 USC § 103(a) as being anticipated by Rodriguez in view of Wen.

For similar reasons to those presented above, claim 11 is believed to be separately allowable wherein it recites "one or more enhancement components…which correspond to a plurality of enhancements available to the paid inclusion customer". Wherein the cited art is silent as to paid inclusion customer enhancement of paid inclusion listings, the cited art does not obviate claim 11. Similarly, claim 14 reciting, "enhancement controller component temporarily hides or suppresses one or more enhancements based at least in part upon user preferences", is believed to be allowable over the cited art wherein the enhancements are the paid inclusion listing enhancements applied with regard to the paid inclusion listing customer. As well, claim 20 is believed to be allowable for reciting, "assist the paid inclusion customer in optimizing listing performance and revenues" wherein neither Rodriguez nor Wen disclose optimizing for a paid inclusion listing customer. Similar paid inclusion customer-centric language is present in claim 22, "reporting performance of at least a subset of the plurality of rendered listings to respective paid inclusion customers to facilitate optimizing listing performance and revenues". Claims 22 is thus believed to be allowable.

IV. Rejection of Claims 3, 13, 16-18, 22 and 30 Under 35 U.S.C. §103(a)

Claims 3, 13, 16-18, 22, and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez (US 2004/0059720 A1) and Wen (US 2001/0047297 A1) as applied to claims 1 and 15, and further in view of Petropolous et al. (US 7,042,502 B2). Applicants respectfully disagree for at least the following reason. Independent claim 1, from which claims 3, 5 and 13 depend; independent claim 15, from which claims 16-18 depend; and independent claim 21 from which claims 22 and 30 depend, are believed to be allowable over Rodriguez in view of Wen, as asserted *supra*. Petropoulos does not correct this particular deficiency wherein Petropoulos discloses, in an aspect, human interactive devices in relation to the context of a displayed item. The rejection of dependant claims 3, 13, 16-18, 22, and 30 under 35 U.S.C. §103(a) is obviated and the Applicants respectfully request that the Examiner withdraw the rejection of claims 3, 13, 16-18, 22, and 30 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Wen, in further view of Petropoulos.

Moreover, with regard to claim 13, Petropoulos is directed to generally reporting how well a search result matched a query. This is not similar to specifically reporting out information to a paid inclusion customer specifically as claimed. The paid inclusion customer is more than a mere user and the inclusion of a listing is more specialized than a generalized search result as previously asserted. As such, Petropoulos does not disclose of suggest the recited claim language, "a reporting component that provides reports comprising at least one of [paid inclusion] listing performance data, user feedback, historical data, or comparisons to historical data ***to the paid inclusion customer to facilitate optimizing revenues***", emphasis added. As such, claim 13 is believed to be further patentably distinct over the cited art.

Similar arguments apply to claim 16, which recites, "reporting component that provides reports to respective paid inclusion customers regarding their respective listings and performance thereof". Also claim 17, reciting, "monitoring component…to facilitate balancing the [paid inclusion listing] customer's enhancement selections with implicit user preferences". Whereas both claim 16 and 17 are directed to monitoring the interaction of the user with the particularities of the paid inclusion listing and optimizing the use of enhancements, the cited art does not obviate these aspects. As such claims 16 and 17 are believed to be allowable.

V. Rejection of Claim 31 and 32 Under 35 U.S.C. §103(a)

Claims 31 and 32 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez (US 2004/0059720 A1) in view of Petropolous et al. (US 7,042,502 B2). Applicants respectfully disagree for at least the following reason. Independent claim 31, from which claim 32 depends, is believed to be allowable over Rodriguez in view of Petropolous, for reasons similar to those asserted *supra*. Rodriguez merely discloses the existence of paid inclusion listening and Petropolous merely discloses reporting performance data of web search results. Whereas claim 31 is directed to intentionally forming test sets of claims, with determinable differences, by selectively applying paid inclusion listing customer enhancements to paid inclusion listings. Neither Rodriguez nor Petropolous disclose or suggest this aspect. The use of official notice is ineffective because it still does not render obvious the use of paid inclusion listings from Rodriguez. Where Rodriguez in fact disparages paid inclusion listings, it is improbable that one of skill in the art would make the leap to designing testable sets of modifications to paid inclusion listings in light of the disparagement. Further, Petropolous is silent with regard to gathering and reporting data on paid inclusion listings which are distinct from general search results as asserted *supra*. Thus where claim 31 recites, "***enhancing…least one paid inclusion listing, with at least a first paid inclusion customer selected enhancement…enhancing at least a second…paid inclusion listing, with at least a second enhancement***, the second paid inclusion customer selected enhancement being different from the first paid inclusion customer selected enhancement such that the modified paid inclusion listing is different…and…reporting at least one of performance, user historical data, or end-user behavior with respect to the first and second subsets of the plurality of listings ***to respective paid inclusion customer to optimize listing performance and revenues***", (emphasis added) the claim is believed to be allowable over the cited art. Applicants respectfully request that the rejection of claims 31 and 32 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Petropolous be withdrawn and the claims allowed at an early date.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP514US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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